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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/544,084

Applicant(s)

SAEBO ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The Request for a Continued Examination (RCE) under 37 CFR 1.114 filed on December 2, 2002 based on parent Application No. 09/544084 is acceptable and a RCE has been established. An action on the RCE follows.

1. Receipt of applicants' amendments and remarks submitted December 2, 2002 is acknowledged.

### *Double Patenting Rejections*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-16 of U.S. Patent No. 6,015,833 in view of Cook et al. (U.S. 5,760,082). Patent '833 claim food product containing conjugated linoleic acid. The Patent does not claim food product contains the derivatives of conjugated linoleic acid, e.g., ester, or the employment of vitamin E in the food products. However, Cook teach that the derivative of conjugated linoleic acid, including esters, are similarly useful as the free acid in food products. See, column2, lines 62-67. It is well known that alcohols or vitamin E are frequently added to food products. Therefore, it would have been obvious for an ordinary skill in

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the art at the time the claimed invention was made to making food product containing conjugated linoleic acid derivatives, including ester, alcohols or vitamin E.

3. Please note a terminal disclaimer has not been received by the office.

***Claim Rejection 35 U.S.C. 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 7-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 4 recites "said food stuff in step (b)," there is no food stuff in step (b). the claim is indefinite as to where is the food stuff come from.

7. Claim 7, step e) recites "combining said foodstuff with said conjugated linoleic acid ester from step (c)" Note step (c) herein yield linoleic acid, not ester. Further, it is not clear what the function of step (d) herein.

8. Claim 13, step d) appears redundant since the final step of making the food product does not need step d).

***Claim Rejections 35 U.S.C. §103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (U.S. Patent 5,760,082 of record) in view of Cain et al. (WO 97/18320, IDS 35) and Baltes et al. (U.S. Patent 3,162,658, of record).

11. Cook teaches a food product containing conjugated linoleic acids, their esters, salts or mixtures. The linoleic acid compounds may be from corn oil, safflower etc. the food products may further containing vitamins. The conjugated linoleic acid may be in the forms of free acid, non toxic salt or esters, such as triglycerides. See, particularly, the abstract, column 1, lines 10-13, lines 49-60. Column 2, lines 51-67, Examples 2- 5. Cook teaches that employment of alkali catalyst for making conjugated linoleic acid moiety for linoleic acid moiety is known. See, particularly, example 1, in column 2. Cook further teaches that conjugated linoleic acid may be incorporated into various food products. See column 5, lines 6-14.

12. Cook does not teach expressly to employ antioxidants such as vitamin E in the food products or the conjugated linoleic acid compounds are produced by the method herein, e.g., treating linoleic acid with potassium methylate, or particularly reduce the volatile organic compounds to the level of 5 ppm.

13. However, Cain et al. teaches that it is well-known in the art that antioxidants, such as vitamin E or BHT, is known to be useful in food product containing conjugated linoleic acid compounds, e.g., conjugated linoleic acid ester. See, particularly, page 6, lines 29-36, the examples 1-20 and the claims. Cook teaches that any solvent in CLA should be removed under vacuum, and CLA is stored in a condition no oxidation would happen (under Argon, in dark and low temperature) before the CLA could be used in food product. See, particularly, column 2,

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lines 40-47. Baltes teach that isomerization of linoleic acid compounds to conjugated linoleic acid compounds by alcoholate catalysts, such as potassium methylate is well known. See, particularly, the examples 2-4 and the claims. The employment of alkali monohydric alcoholate has advantage that isomerization is possible without using more than stoimetical amounts of alkali metal alcoholate. See column 2, lines 31-35.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidant in a food product, wherein the CLA is free of volatile organic compounds and free of oxidation.

A person of ordinary skill in the art would have been motivated to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidants in a food product, wherein the CLA is free of volatile organic compounds and free of oxidation because CLA is known to be sensitive to oxidation and antioxidant are known to be useful along with conjugated linoleic acid compounds in food products. Regarding the limitation about the method to obtain the conjugated linoleic acid, note a method of making ingredients is not seen to render patentable weight to a method which employs such ingredients, absent evidence to the contrary. It is particularly truth if the method of making the ingredients is a well-known process, e.g., employ alkali monohydrolic alcoholate for making conjugated linoleic acid. A process of making a composition by simply combining or mixing the known ingredients is seen to be within the skill of the artisan. Further, purifying CLA composition by using silica gel (adsorbent) is seen to be obvious since silica gel is well known for purification and separation purpose.

### Response to the Arguments

Applicants' amendments and remarks, submitted December 2, 2002 have been fully considered, but are not persuasive for reasons discussed below.

14. The double patenting rejection is maintained because a terminal disclaimer has not been received.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestions or motivation are found in both the references and in the knowledge generally available to one of ordinary skill in the art. Initially, it is noted that Cook employed alcoholate catalyst for preparing the conjugated linoleic acid. (ethylene glycol is a dihydric alcohol). The examiner restated that Baltes reference does not expressly limited to produce CLA for coating. Note question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. *In re Lamberti and Konort* (CCPA), 192 USPQ 278. Contrary to applicants' assertion, Baltes state "The invention relates to a process for substantially complete catalytic conversion of compounds of unconjugated polyethenoid acid into compounds of conjugated enthenoid acid." (column 1, lines 13-16). "It will be appreciated from the above that this

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invention is not limited to the materials, steps, conditions and other details specifically described above and can be carried out with various modification. Thus, it will be understood that the process of this invention is broadly applicable to **any unconjugated polyethenoid acid compounds and products containing them.**" (column 8, lines 20-50, examiner emphasis added ). In view of all the references cited, it become obvious to take a proper linoleic acid esters and treat the esters with alkali alcoholate according Baltes to obtain a CLA and incorporate the CLA in a food product. Thus, in view all the cited references as while, making a conjugated linoleic acid compound by employing alcoholate catalyst is obvious.

16. Applicants assert that the references do not teach all of the elements of the claims, particularly, the cited reference do not teaches that CLA compositions are treated so that less than 5 ppm of volatile organic materials are present. The assertion is not persuasive. As stated above, Cook teaches a step to remove volatile components in the CLA composition and keep the composition from oxidation. It would be obvious for one of ordinary skill in the art to keep the level of volatile organic materials low so that the CLA composition would suitable for food product.

17. Applicants assert that the cited references provide no reasonable expectation of success, because the references does not expressly teach a step for reducing the level volatile organic materials to less than 5 ppm, and a number of procedures was necessary to assure such level. First, as suggested by Cook, the presence of high level of volatile organic materials in CLA composition would make the composition unsuitable for food product. Cook's CLA composition is suitable for food product, thus, the level of volatile organic materials is low. No evidence



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showing that CLA composition treated by the method of Cook (vacuum, under argon, dark and low temperature) would still have any volatile organic materials.

18. Nothing unobvious is seen in the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner



Shengjun Wang

January 17, 2003